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GROUP 3600

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 28

Application Number: 09/267,489
Filing Date: March 11, 1999
Appellant(s): WALKER ET AL.

Magdalena Fincham
For Appellant

EXAMINER'S ANSWER

This is in response to the supplemental appeal brief filed 02 March 2004.

(1)   Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2)   Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3)   Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4)   Status of Amendments After Final

The Appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5)   Summary of Invention

The summary of invention contained in the brief is correct.

(6)   Issues

The Appellant's statement of the issues in the brief is correct.

(7)   Grouping of Claims

Appellant's brief includes a statement that claims 1-50 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8)   Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9)   Prior Art of Record

6,167,435 A   Druckenmiller et al.   12-2000

6,292,785 B1   McEvoy et al.   09-2001

"How to Generate Online Leads from the Web" Interactive Marketing News v3,

n10. May 10, 1996.

(10)   Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Allowable Subject Matter

Claims 5-7, 18-20, 31-34, 43, 45, and 46 are objected to as being dependent

upon a rejected base claim, but would be allowable if rewritten in independent

form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 103

Claims 1-4, 8-12, 14-17, 21-25, 27-30, 35-42, 44, and 47-50 are rejected under

35 U.S.C. 103(a) as being unpatentable over Druckenmiller et al (US 6,167,435)

in view of "How to Generate Online Leads from the Web" (Interactive Marketing

News; 10 May 1996), in view of Applicant's own admission.

Claims 1, 27, and 39:

Sending an automated verification email message to the mailing list

member and receiving a response from the member (column 2, lines 10-19).

Selecting a mailing list from a plurality of mailing lists according to a demographic, product, service, or other relevant subject (column 1, lines 14-15, column 3, lines 4-13 and lines 55-61).

Druckenmiller does not specifically disclose a postal mailing address. However, using a postal address as a correlation to an email address is an obvious choice relative to a demographic profile. In the specification, applicant states, "the subset of list members...can be selected with an eye toward various factors such as the demographics of the particular members, because the postal mailing lists are already compiled based on such factors." Druckenmiller, in column 7, lines 18-22 discloses, "demographic information for the subscribers may also be contained within each mailing list. Such demographic information may then be used to select only specific subscribers to a list according to various requirements." It would have been obvious to one of ordinary skill in the art at the time of the invention to use the demographic of a postal mailing address as a selection device for identifying possible mail recipients. Using a postal mailing address geographically identifies a target audience, and is already a well known practice in the targeted marketing practices.

In addition, Druckenmiller does not specifically disclose sending an email message to the member on the list. However, "How to Generate Online Leads from the Web" discloses using postal address mailing lists, sending a questionnaire that includes postal mailing address fields and email address fields, asking recipients to submit their email address, and if they would like to be

added to the mailing list. Naturally, if a recipient responds with correct or updated contact information, either by email or by postal mail, the recipient can be regarded as a verified lead. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Druckenmiller with "How to Generate Online Leads from the Web" because using email to verify postal addresses and to further target recipients provides good leads and increases potential profitability.

With regard to selection of one or a plurality of mailing lists over another, Applicant readily admits that choosing a proper mailing list is crucial (see specification, pages 1-3). Basing that choice on the responses from a email sent out to each member on the list for verification and confirmation of accurate mailing data would be an obvious modification of Druckenmiller and "How to Generate Online Leads from the Web" because, as disclosed by the Applicant, "It is believed that the choice of mailing list is one of the most critical factors related to the success of a direct marketing campaign. This is because the best list can often result in the times the response as the worst list for an identical mailing piece."

Claim 14:

The limitations of Claim 14 are of the same scope as the limitations of Claim 1, and are therefore rejected on the same basis, with the following noted exceptions. Claim 14 recites a processor, database, communication port, and a memory. Druckenmiller discloses a computer and a database in Figure 1.

Claims 2, 15, 28, and 40:

Shown above, Druckenmiller discloses the subscription verification method as disclosed in the rejections of Claims 1, 14, 27, and 39. Druckenmiller does not disclose selling the mailing lists. Applicant, however, on page 2, line 10 of the specification, discloses a business purchasing a mailing list, inherently disclosing that a mailing list is bought and sold as a marketable item. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the practice of creating a mailing list and then selling the mailing list because a reliable and accurate list of customer leads is a valuable asset, and acquiring such lists provides an opportunity to expand an organization's customer/client base, thereby generating potential growth.

Claims: 3, 16, 29, and 41:

Shown above, Druckenmiller discloses the subscription verification method as disclosed in the rejections of Claims 1, 14, 27, and 39. Druckenmiller does not disclose renting the mailing lists. Applicant, however, on page 2, lines 8-9 of the specification, discloses that a mailing list may be rented. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the practice of creating a mailing list and then renting the mailing list because a reliable and accurate list of customer leads is a valuable asset, and acquiring such lists provides an opportunity to expand an organization's customer/client base, thereby generating potential growth. Renting is an option

to purchasing the list because the accuracy of the list may decrease after a period of time, driving the value of the list downward.

Claims 4, 17, 30, and 42:

Shown above, Druckenmiller discloses the subscription verification method as disclosed in the rejections of Claims 1, 14, 27, and 39. Druckenmiller does not disclose renting the mailing lists. Applicant, however, on page 1, line 29 to page 2, line 1 of the specification, discloses that a mailing list may be used to "mail promotional items such as brochures, advertisements, or sales offers to persons included in the list." It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the practice of creating a mailing list and then mailing items to members on the mailing list because a reliable and accurate list of customer leads is a valuable asset, and acquiring such lists provides an opportunity to expand an organization's customer/client base, thereby generating potential growth. Directly mailing brochures, advertisements, or sales offers promotes reasonable expansion by selectively targeting individual and groups who may be interested in involving themselves with the organization.

Claims 8, 35, and 47:

A test identifier i.e. token (column 5, lines 17-20), a member identifier i.e. email address (column 5, line 2), creating and retrieving the test record, and updating the record based on member response (column 5, lines 34-54).

Claims 9, 36, and 48:

Questions in the form of topics of interest and the answers and other demographic data are submitted to the mailing list database (column 3, lines 4-13).

Claims 10, 37, and 49:

Mailing list selection based on the answers to the demographic/topic of interest questions (column 6, lines 34-42).

Claims 11, 21, 34, 38, and 50:

Indicating the importance of a maximized response rate (column 8, lines 19-32). Inherently, selection of mailing lists that provide positive proof of increased and voluntary participation by the members on the mailing list are more valuable than lists which have old, untested, or unresponsive members. In addition, mailing lists with low response rates are considered less than ideal (column 1, lines 14-23), versus mailing lists with greater response rates, which are inherently more valuable to the organization attempting to profit from the list (column 1, lines 40-41). Also, it is inherent to the development of evaluating the usefulness of a mailing list by its response rate to calculate and determine a quantitative or qualitative grade of the rate of member response. Furthermore, when selecting a mailing list for deployment, response rate is an inherent factor.

Claims 12:

Response to the message is made through a URL (column 2, lines 16-19).

Claim 22:

A test identifier i.e. token (column 5, lines 17-20), a member identifier i.e. email address (column 5, line 2), creating and retrieving the test record, and updating the record based on member response (column 5, lines 34-54).

Claim 23:

Questions in the form of topics of interest and the answers and other demographic data are submitted to the mailing list database (column 3, lines 4-13).

Claim 24:

Indicating the importance of a maximized response rate (column 8, lines 19-32). Inherently, selection of mailing lists that provide positive proof of increased and voluntary participation by the members on the mailing list are more valuable than lists which have old, untested, or unresponsive members. In addition, mailing lists with low response rates are considered less than ideal (column 1, lines 14-23), versus mailing lists with greater response rates, which are inherently more valuable to the organization attempting to profit from the list (column 1, lines 40-41). Also, it is inherent to the development of evaluating the usefulness of a mailing list by its response rate to calculate and determine a quantitative or qualitative grade of the rate of member response. Furthermore, when selecting a mailing list for deployment, response rate is an inherent factor.

Claim 25:

Response to the message is made through a URL (column 2, lines 16-19).

Claim 44:

Storing the data concerning the member, such as subscriber information from the subscription form (column 6, lines 42-50).

Claims 13 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Druckenmiller in view of "How to Generate Online Leads from the Web" (Interactive Marketing News; 10 May 1996), in view of McEvoy et al., United States Patent Number 6,292,785, hereafter referred to as "McEvoy."

Claims 13 and 26:

Shown above, Druckenmiller discloses the subscription verification method as disclosed in the rejections of Claim 1. Druckenmiller does not disclose compensating list members with an incentive. McEvoy, however, in column 5, lines 13-27, discloses an incentive as one of many possible services of the marketing research campaign compiling a mailing list. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the practice of creating a mailing list and compensating members who join the list because a reliable and accurate list of customer leads is a valuable asset, and enticing members with an incentive is a proven and effective way to increase participation, thereby increasing the value of the mailing list.

(11)   Response to Argument

Issue 1 – Item 1.3.

The Appellant asserts that there is no prima facie showing of patentability of the claims of a group 1. The Examiner respectfully disagrees and points to the rejections as shown above.

Issue 1 – Item 1.3.1.

The Appellant asserts that *there is no showing it that the references suggest selecting for use one of the postal mailing list from the plurality of postal mailing lists based on responses to an email message that was sent, for each postal mailing list in the plurality of postal mailing lists, to each of a subset of list members.* The Examiner for respectfully disagrees and points the rejections of claim 1 above, one wherein Druckenmiller teaches sending an automated verification email message to the mailing list member and receiving a response from the member and selecting a mailing list from a plurality of mailing lists according to a demographic, product, service, or other relevant subject, as well as "demographic information for the subscribers may also be contained within each mailing list. Such demographic information may then be used to select only specific subscribers to a list according to various requirements." In addition, Appellant readily admits that choosing a proper mailing list is crucial (see specification, pages 1-3). Basing that choice on the responses from a email sent out to each member on the list for verification and confirmation of accurate mailing data would be an obvious modification of Druckenmiller and "How to

Generate Online Leads from the Web" because, as disclosed by the Appellant, "It is believed that the choice of mailing list is one of the most critical factors related to the success of a direct marketing campaign. This is because the best list can often result in the times the response as the worst list for an identical mailing piece." Furthermore, Appellant, in the background of the specification specifically states, "this is because the best list can often result in 10 times the response as the worst list for an identical mailing piece (page 2, lines 4-10). Here, the Appellant is specifically stating the relative value of the accurate, updated, and complete mailing list, and that multiple mailing lists are known to one of ordinary skill in the direct mailing arts.

Issue 1 – Official Notice

The Appellant asserts that *the Examiner appears to also be justifying the rejection of claim 1 with what appears to be Official Notice.* However, the rejection of claim 1 is in no way, either in part or wholly, based on Official Notice. Nowhere in the rejection do the phrases "Official Notice" or "old and well known" appear in the rejection, nor was it the Examiner's intent to suggest or otherwise make use of Official Notice as part of the rejection of claim 1.

Issue 1 – Item 1.3.2.

The Appellant asserts that *there is no showing that the references suggest sending, for each postal mailing list in the plurality of postal mailing lists, an email message to each of a subset of list members.* The Examiner respectfully disagrees, and points to the rejection of claim 1, above, wherein the rejection

states, "*How to Generate Online Leads from the Web* discloses using postal address mailing lists, sending a questionnaire that includes postal mailing address fields and email address fields, asking recipients to submit their email address, and if they would like to be added to the mailing list." In addition, Druckenmiller teaches sending an automated verification email message to the mailing list member and receiving a response from the member and selecting a mailing list from a plurality of mailing lists according to a demographic, product, service, or other relevant subject, as well as "demographic information for the subscribers may also be contained within each mailing list. Such demographic information may then be used to select only specific subscribers to a list according to various requirements." The combination discloses the Appellant's limitation.

Issue 1 – Item 1.3.3.

The Appellant asserts that *there is no showing of a proper motivation to combine the references*. The Examiner respectfully disagrees and points to the statement voluntarily submitted in the background of the application by the Appellant: "It is believed that the choice of mailing list is one of the most critical factors related to the success of a direct marketing campaign. This is because the best list can often result in the times the response as the worst list for an identical mailing piece." Since each of the references disclose an analogous approach to direct mailing and the compilation of mailing list either traditionally or through a computer network, the motivation provided by the appellate as well as

the motivation shown in the rejections above disclose the proper combination of the prior art of record.

Issue 1 – item 1.3.4.

The Appellant asserts that the prior art reference is *nonanalogous* art. The Examiner respectfully disagrees. Each of the references discloses an analogous approach to direct mailing and the compilation of mailing list either traditionally or through a computer network.

Issue 1 – item 2.3.1.

The Appellant asserts that *there is no showing that the references suggest selecting for use the postal mailing list that has a response rate higher than the response rates of the other postal mailing lists.* The Examiner respectfully disagrees had points to the rejection of claim 11 above. Summarized, the Rejection states that inherently, selection of mailing lists that provide positive proof of increased and voluntary participation by the members on the mailing list are more valuable than lists which have old, untested, or unresponsive members. Mailing lists with low response rates are considered less than ideal and mailing lists with greater response rates are inherently more valuable to the organization attempting to profit from the list. Also, it is inherent to the development of evaluating the usefulness of a mailing list by its response rate to calculate and determine a quantitative or qualitative grade of the rate of member response. Furthermore, when selecting a mailing list for deployment, response rate is an

inherent factor. Appellant's statement in the background of the specification also lends credence to the Examiner's rejection.

Issue 1 – Official Notice

The Appellant asserts that *the Examiner appears to also be justifying the rejection of claim 11 with what appears to be Official Notice.* However, the rejection of claim 11 is in no way, either in part or wholly, based on Official Notice. Nowhere in the rejection do the phrases "Official Notice" or "old and well known" appear in the rejection, nor was it the Examiner's intent to suggest or otherwise make use of Official Notice as part of the rejection of claim 11.

Issue 1 – item 2.3.2.

The Appellant asserts that *there is no showing of a proper motivation to combine the references.* The Examiner respectfully disagrees and points to the statement voluntarily submitted in the background of the application by the Appellant: "It is believed that the choice of mailing list is one of the most critical factors related to the success of a direct marketing campaign. This is because the best list can often result in the times the response as the worst list for an identical mailing piece." Since each of the references disclose an analogous approach to direct mailing and the compilation of mailing list either traditionally or through a computer network, the motivation provided by the appellate as well as the motivation shown in the rejections above disclose the proper combination of the prior art of record.

Issue 1 – Item 2.4.1.

The Appellant asserts that *there is no showing that the references suggest selecting for use the postal mailing list that has a response rate higher than the response rates of the other postal mailing lists.* The Examiner respectfully disagrees had points to the rejection of claim 11 above. Summarized, the rejection states that inherently, selection of mailing lists that provide positive proof of increased and voluntary participation by the members on the mailing list are more valuable than lists which have old, untested, or unresponsive members. Mailing lists with low response rates are considered less than ideal and mailing lists with greater response rates are inherently more valuable to the organization attempting to profit from the list. Also, it is inherent to the development of evaluating the usefulness of a mailing list by its response rate to calculate and determine a quantitative or qualitative grade of the rate of member response. Furthermore, when selecting a mailing list for deployment, response rate is an inherent factor. Appellant's statement in the background of the specification also lends credence to the Examiner's rejection.

Issue 1 – Item 3.3.1.

The Appellant asserts that *there is no showing that the references suggest mailing information via post to list members of the postal mailing list that had previously been selected based on responses to an email message that had been sent, for each of the plurality of postal mailing lists including the selected postal mailing list to reach out of a subset of list members.* The Examiner respectfully disagrees had points to the rejection of claim 4 above, which, in

summary, shows the selection process for selecting mailing list and mailing information to the mailing list recipients.

Issue 1 – Item 3.3.2.

The Appellant asserts that *there is no showing of a proper motivation to combine the references.* The Examiner respectfully disagrees and points to the statement voluntarily submitted in the background of the application by the Appellant: "It is believed that the choice of mailing list is one of the most critical factors related to the success of a direct marketing campaign. This is because the best list can often result in the times the response as the worst list for an identical mailing piece." Since each of the references disclose an analogous approach to direct mailing and the compilation of mailing list either traditionally or through a computer network, the motivation provided by the appellate as well as the motivation shown in the rejections above disclose the proper combination of the prior art of record.

Issue 1 – Item 4.3.1.

The Appellant asserts that *there is no showing that the references suggest compensating a list member associated with the response for the response.* The Examiner respectfully disagrees, and points to the rejection of claims 13 above wherein McEvoy discloses an incentive as one of many possible services of the marketing research campaign compiling a mailing list.

Issue 1 – Item 4.3.2.

The Appellant asserts that *there is no showing of a proper motivation to combine the references.* The Examiner respectfully disagrees and points to the statement voluntarily submitted in the background of the application by the Appellant: "It is believed that the choice of mailing list is one of the most critical factors related to the success of a direct marketing campaign. This is because the best list can often result in the times the response as the worst list for an identical mailing piece." Since each of the references disclose an analogous approach to direct mailing and the compilation of mailing list either traditionally or through a computer network, the motivation provided by the appellate as well as the motivation shown in the rejections above disclose the proper combination of the prior art of record.

Issue 1 – Item 4.4.

The Appellant asserts that the prior art reference is *nonanalogous* art. The Examiner respectfully disagrees. Each of the references discloses an analogous approach to direct mailing and the compilation of mailing list either traditionally or through a computer network.

Issue 1 – Item 4.5.1.

The Appellant asserts that *the references do not suggest compensating a list member associated with the response for the response.* The Examiner respectfully disagrees, and points to the rejection of claim 13 above wherein

McEvoy discloses an incentive as one of many possible services of the marketing research campaign compiling a mailing list.

Issue 1 – Item 5.3.1.

The Appellant asserts that *there is no showing that the references suggest the treating a test record from the test database based on the received test to identify which test record is in turn updated to disclose, based on the received member identifier, that a response was received from a member associated with the member identifier.* The Examiner respectfully disagrees, and points to the rejection of claim 8 above which shows a token, a member identifier i.e. email address, creating and retrieving the test record, and updating the record based on member response.

Issue 1 – Item 5.3.2.

The Appellant asserts that *there is no showing of a motivation to modify the references.* The Examiner respectfully disagrees and points to the statement voluntarily submitted in the background of the application by the Appellant: "It is believed that the choice of mailing list is one of the most critical factors related to the success of a direct marketing campaign. This is because the best list can often result in the times the response as the worst list for an identical mailing piece." Since each of the references disclose an analogous approach to direct mailing and the compilation of mailing list either traditionally or through a computer network, the motivation provided by the appellate as well as the

motivation shown in the rejections above disclose the proper combination of the prior art of record.

Issue 1 – Item 5.4.1.

The Appellant asserts that *the references do not suggest receive response that includes a test identifier and a member identifier, where the test identifier is used to retrieve a test record from a test database and the member identifier these use to update the test record to disclose that the response was received from a member associated with the member identifier.* The Examiner respectfully disagrees, and points to the rejection of claim 8 above which shows a token, a member identifier i.e. email address, creating and retrieving the test record, and updating the record based on member response.

Issue 1 – Item 6.3.1.

The Appellant asserts that *the references to not suggest sending a first email message to a first member of a postal mailing list and sending a second email message to a second member of the postal mailing list, wherein the first email message includes content different from the email second message.* This assertion is moot since the Examiner has indicated claim 5 as allowable.

For the above reasons, it is believed that the rejections should be sustained.

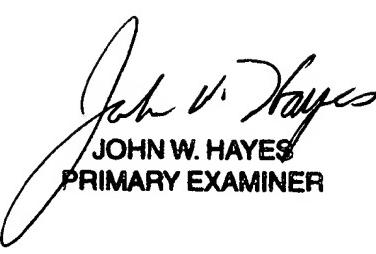Respectfully submitted,

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